

REMARKS

Claims 1-54 remain pending in this application. No claims have been amended, cancelled, or added. No new matter has been added.

With the present response, applicant encloses a Request for Approval of Drawing Changes to change one of the flags shown in box 102 of the flowchart of fig. 9 from "1" to --0--. Support for the proposed amendment can be found in the specification, for example, on p. 9, lines 7-10. Applicant therefore submits that no new matter is proposed. Entry of the proposed drawing amendment is thus hereby requested.

Claims 1-3, 10, 12, 13, 17-21, 28, 30, 31, 35-40, 47, 49, 50, and 54 stand rejected under 35 U.S.C. § 102 as anticipated by *Tanaka* (U.S. Patent No. 6,100,876). Applicant respectfully traverses this rejection.

Regarding claim 1, applicant notes that claim 1 recites the step of "detecting the length of time of a non-touch state in which no touch motion is performed ..." To address this step, the Office Action provides a reference to *Tanaka's* pen-up time tUP.

However, *Tanaka's* pen-up time t_{UP} does not represent a "length of time" as claimed. Instead, pen-up time t_{UP} represents an *instant* in time, used with pen-down time t_{DOWN} ,¹ to determine the time interval Δt_{DOWN} between pen-down and pen-up. (See col. 9, lines 18-22.) Therefore, *Tanaka's* pen-up time t_{UP} cannot anticipate the "length of time of a non-touch state" of the first step of claim 1. For at least this reason, the anticipation rejection of claim 1, and accordingly all claims depending from therefrom (that is, claims 2, 3, 10, 12, 13/1, 13/2, 13/3, 17, and 18), should be withdrawn.

Additionally, the second step of claim 1 requires use of the "detected length of time" to determine information indicating a touch state. Because *Tanaka* does not teach the "length of time" as claimed, it cannot anticipate the second step. For this additional reason, *Tanaka* cannot anticipate claim 1 nor the claims depending therefrom.

Regarding claim 19, this claim is interpreted in the Office Action as an apparatus claim counterpart of method claim 1. *Tanaka* is accordingly applied to reject these claims in an analogous manner. The deficiency of *Tanaka* to anticipate claim 1 is explained above. Because the same rationale is relied upon to reject claim 19, the anticipation rejection of claim 19, and the rejected claims depending from therefrom (that is, claims 20, 21, 28, 30, 31/19, 31/20, 31/21, and 35-37), should be withdrawn for at least the reasons discussed above in reference to claim 1.

¹Applicant finds no *explicit* definition in *Tanaka* for either the term "pen-up time t_{UP} " or "pen-down time t_{DOWN} ." However, one can readily understand from context that the former term refers to the point in time when pen 6 discontinues contact with tablet 32, and that the latter term refers to the point in time when pen 6 begins/resumes contact with tablet 32

Regarding claim 38, the rejection relies on the *Tanaka* teachings applied against claim 1 and on an additional citations to col 4, lines 7-11, regarding a V-RAM. Because of the deficiency of *Tanaka* to anticipate claim 1 (discussed above), the anticipation rejection of claim 38, and the rejected claims which depend from claim 38 (that is, claims 39, 40, 47, 49, 50/38, 50/39, 50/40 and 54), should be withdrawn for at least the reasons discussed above in reference to claim 1.

Claims 4-6, 22-24, and 41-43 stand rejected under 35 U.S.C. § 102 as anticipated by *Kubota et al.* (U.S. Patent No. 5,956,021). Applicant respectfully traverses this rejection.

Regarding claim 4, and claim 5 depending therefrom, applicant notes that the claim 4 method includes a step of "detecting the *number of successive* occurrences" (emphasis added) of the touch motion on an operating surface. In another step of claim 4, information indicating a touch state is determined in accordance with the "detected number of occurrences." Applicant finds no teaching of such method in *Kubota et al.*

The anticipation rejection relies on *Kubota et al.* to supposedly teach the claim 4 steps. The Office Action provides a citation to *Kubota et al.*, col. 3, lines 43-50. Here, the reference teaches that a pen "keeps pressing" a key for a given time period to select a desired key from a group of related keys. This is different from the steps described in claim 4. The data used for the claim 4 method is the *number* of occurrences, and the *Kubota et al.* method instead uses a *length of time* (a "given time period", col. 3, lines 42-43). It would not be proper to interpret the *Kubota et al.* recitation "keeps pressing" as meaning --executes multiple press operations--. Instead, one can see,

especially in view of the accompanying recitation "for a given time period" (col. 3, lines 43-44), that *Kubota et al.* teaches a method step of pressing a key *one* time (not "successive" times) and holding it down, with the time period in which the key is held down being indicative of the user's selection.

Applicant acknowledges that the Office Action also provides a cite to col. 2, line 50, through col. 3, line 11, of *Kubota et al.* Although lines 7-9 of col. 3 refer to an method where a pen is placed on a tablet "twice or more," this is not a teaching of "*detecting the number* of successive occurrences" of the touch motion, and there is no teaching of using such a detected number to indicate a touch state as claimed. Therefore, *Kubota et al.* cannot anticipate claims 4 and 5. Withdrawal of the anticipation rejection of claims 4 and 5 under 35 U.S.C. § 102 is thus hereby requested.

Claim 6, similar to claim 4, recites the step of "detecting the number of occurrences" of the touch motion and another step of "determining information indicating a touch state in accordance with said detected number of occurrences." The Office Action provides no additional interpretation or elaboration of the *Kubota et al.* reference with respect to claim 6. Applicant submits that *Kubota et al.* does not teach the steps of claim 6. Therefore, *Kubota et al.* cannot anticipate claim 6, and the rejection 35 U.S.C. § 102 should be withdrawn.

The Office Action next explains that claims 22-24 and 41-43 stand rejected using the same interpretation of *Kubota et al.* used to reject claims 4 and 5. As explained above, *Kubota et al.* is misinterpreted to support the anticipation rejection of claims 4 and 5. Therefore, the anticipation

rejection of claims 22-24 and 41-43 should be withdrawn for at least the reasons provided above regarding the rejection of claims 4 and 5.

Claims 15, 33, and 52 stand rejected under 35 U.S.C. § 102 as anticipated by *Weber et al.* (U.S. Patent No. 5,572,651). Applicant respectfully traverses this rejection.

Claims 15, 33, and 52 each recite "detecting the number of successive occurrences" of a touch motion on an operating surface and "determining a corresponding mouse operation in accordance with said detected number of occurrences." However, as explained next, the Office Action does not properly provide the required teachings by of the claimed steps *Weber et al.* to justify the anticipation rejection:

Applicant acknowledges the citation to col. 19, lines 9-22, which discusses how a pen is used analogously to a mouse as an input device. This portion of *Weber et al.* also discloses that input corresponding to a single letter or single word "may be made up of a number of strokes" (lines 16-18). However, *Weber et al.* does not teach *counting* the number of strokes and *using that number* to determine a mouse operation.

To properly justify the anticipation rejection, the Office Action would need to show either explicit or inherent support in the applied reference for each of the claimed steps. As discussed above, *Weber et al.* does not explicitly teach determining corresponding mouse operation based on a detected number of occurrences of touch motions as claimed. Regarding inherent teachings of the

claimed steps, the Office Action provides no explanation of how *Weber et al.* would inherently teach these steps. Therefore, the anticipation rejection is not properly justified. Accordingly, applicant respectfully requests the withdrawal of the anticipation rejection of claims 15, 33, and 52 under 35 U.S.C. § 102.

Claims 7, 8, 25, 26, 44, and 45 stand rejected under 35 U.S.C. § 103 as obvious over *Kubota et al.* Applicant traverses this rejection.

Each of claims 7, 8, 25, 26, 44, and 45 depend from at least one of claims 4, 6, 22, 24, 41, and 43, which stand anticipated by *Kubota et al.* As explained above, *Kubota et al.* cannot anticipate parent claims 4, 22, and 41, because the reference does not teach detecting the number of occurrences of the touch motion on an operating surface and determining information indicating a touch state in accordance with the detected number of occurrences.

Applicant acknowledges that claims 7, 8, 25, 26, 44, and 45 stand rejected as obvious instead of as anticipated. However, only features not recited in the parent claims are deemed obvious. Thus, implicit in the obviousness rejection is that the features recited in the parent claims are taught, not suggested, by *Kubota et al.*

Therefore, because the obviousness rejection is based in part on *Kubota et al.* anticipating the parent claims, applicant submits that claims 7, 8, 25, 26, 44, and 45 are not obvious in view of the reference. Accordingly, withdrawal of the obviousness rejection of claims 7, 8, 25, 26, 44, and

45 under 35 U.S.C. § 103 is hereby requested.

Claims 16, 34, and 53 stand rejected under 35 U.S.C. § 103 as obvious over *Weber et al.* Applicant respectfully traverses this rejection.

Claims 16, 34, and 53 depend from claims 15, 33, and 52, respectively, which, as discussed above, stand anticipated by *Weber et al.* As explained above, the Office Action does not provide a proper justification for *Weber et al.* anticipating parent claims 15, 33, and 52. Applicant acknowledges that claims 16, 34, and 53 stand rejected as obvious instead of as anticipated. However, only features not recited in the parent claims are deemed obvious. Thus, implicit in the obviousness rejection is that the features recited in the parent claims are taught, not suggested, by *Weber et al.*

Therefore, because the obviousness rejection is based in part on *Weber et al.* anticipating the parent claims, applicant submits that claims 16, 34, and 53 are not obvious in view of the reference. Accordingly, withdrawal of the obviousness rejection of claims 16, 34, and 53 under 35 U.S.C. § 103 is hereby requested.

Claims 9, 11, 14, 27, 29, 32, 46, 48, and 51 stand rejected under 35 U.S.C. § 103 as obvious over *Tanaka* in view of *Chan et al.* (U.S. Patent No. 6,057,830). Applicant traverses the rejection as improper.

Each of claims 9, 11, 14, 27, 29, 32, 46, 48, and 51 depend from one of claims 1, 19, and 38, which stand anticipated by *Tanaka*. However, as explained above, *Tanaka* cannot anticipate parent claims 1, 19, and 38, because it fails to teach "detecting the length of time of a non-touch state in which no touch motion is performed ..." and using the "detected length of time" to indicate a touch state.

Applicant acknowledges that claims 9, 11, 14, 27, 29, 32, 46, 48, and 51 stand rejected as obvious instead of as anticipated. Applicant also acknowledges that the rejection relies additionally on *Chan et al.* However, only features not recited in the parent claims are deemed obvious. Thus, implicit in the obviousness rejection is that the features recited in the parent claims are taught, not suggested, by *Tanaka*.

Therefore, because the obviousness rejection is based in part on *Tanaka* anticipating the parent claims, applicant submits that claims 9, 11, 14, 27, 29, 32, 46, 48, and 51 are not obvious in view of the applied references. Accordingly, withdrawal of the obviousness rejection of claims 9, 11, 14, 27, 29, 32, 46, 48, and 51 under 35 U.S.C. § 103 is hereby requested.

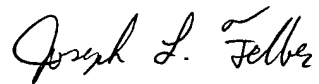
In view of the remarks above, applicant now submits that the present application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested. If for any reason it is felt that this application is not now in condition for allowance, the Examiner is invited to contact applicant's undersigned attorney at the telephone number indicated below to arrange for disposition of this case.

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In the event that this paper is not timely filed, applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

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Enclosures: Request for Approval of Drawing Changes; Two Months Extension of Time (2)

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